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PATENT

#16
P. Allen
10/24/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Weatherill et al.
Appl. No. : 09/777,420
Filed : February 6, 2001
For : REEL HOUSING WITH
DECORATIVE ACCESS
PANEL
Examiner : John Q. Nguyen

) Group Art Unit 3654

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September 19, 2002

(Date)

Sanjivpal S. Gill
Sanjivpal S. Gill, Reg. No. 42,578

REQUEST FOR RECONSIDERATION

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

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Dear Sir:

In response to the Final Office Action mailed on August 6, 2002, please consider the following Remarks:

REMARKS

Reconsideration and allowance of this application is respectfully requested. Claims 1-28 are pending in the application.

Claim Rejections – 35 USC § 103

The Examiner has rejected Claims 1-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,279,848 to Mead, Jr. ("Mead") in view of U.S. Patent No. 5,988,207 to Kownacki et al. ("Kownacki"). Applicants respectfully traverse these rejections because Mead cannot be properly cited against the present application in an obviousness rejection.

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A patent that is prior art only under 35 U.S.C. § 102(e) cannot be cited against an application for an obviousness rejection if the patent and application are co-owned or both under an obligation of assignment to the same "person":

Subject matter developed by another person, which *qualifies as prior art only* under one or more of subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability* under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or *subject to an obligation of assignment to the same person*.

35 U.S.C. §103(c) (*emphasis added*).

The above cited provision "applies to all utility, design, and plant patents *filed on or after November 29, 1999*." M.P.E.P. §706.02(l)(1) (*emphasis added*). Based on these rules, it is clear that Mead cannot be properly cited against the present application in an obviousness rejection. The present application was filed February 6, 2001, which is after November 29, 1999, and, therefore, the rule of §103(c) is applicable under M.P.E.P. §706.02(l)(1). In addition, Mead was filed on November 15, 2000 and issued on August 28, 2001. Thus, Mead qualifies as prior art to the present application only under 35 U.S.C. § 102(e)(1). Furthermore, both Mead and the present application are assigned to Great Stuff, Inc. See, Mead '848 cover page and the separate Assignments from each of the two inventors of the present application, recorded at Reel 012370/Frame 0679 (S. Weatherill) and Reel 011528/Frame 0066 (J. Tracey). Therefore, Mead and the present application are "commonly owned." Accordingly, Mead cannot be properly cited against the present application.

CONCLUSION

For the reasons presented above, Applicants respectfully submit that this application is in condition for allowance. If there is any further hindrance to allowance of the pending claims, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/19/02

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